

REMARKS

After this Amendment, claims 1-5 and new claims 23-39 are now pending in the application. Claims 1, 3, 4, and 5 have been amended. The amendments to the claims and the new claims find support in the specification, for example, at page 3, lines 30-33; pages 7, lines 23-25; page 8, lines 5-11; pages 11 and 12; page 27, lines 5-35; Figures 4-6, 23, and 25-27; and elsewhere in the specification and claims as originally filed. Reconsideration of the previously rejected claims and favorable action is requested in light of the above amendments and the following remarks.

Clarification of Election

Claims 1-5 are pending pursuant to a Response to Restriction Requirement filed on April 13, 2006, which Restriction Requirement was mailed on December 12, 2005. The present Office Action states that “election has been treated as an election without traverse (MPEP § 818.03(a)).” However, Applicants respectfully note that the statement on page 5 of the Response to Restriction Requirement filed on April 13, 2006, states that “Applicant cancels claims 6-22 with traverse.” Thus, although claims 6-22 were said to be canceled on page 3 of that Response, it is clear that the cancellation of the claims was with traverse. Accordingly, Applicants respectfully request that the election be recognized as an election with traverse.

Ahmadi

In the present Office Action, claims 1-5 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,602,911 to Ahmadi et al. (hereafter “Ahmadi”). Insofar as this ground for rejection applies to the present claims, Applicants respectfully traverse.

To establish a prima facie case of anticipation under 35 U.S.C. § 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. MPEP 2131. Applicants respectfully submit that this criterion has not been met for Ahmadi as applied to claims 1-5 of the present invention, as amended.

Ahmadi lacks elements of the claimed invention. Ahmadi discusses an annular device

which engages with a tool. In order for the Ahmadi device and tool to engage, the tool *must* lie along the plane of the annular device. For example, as shown in Figs. 5 and 6 of Ahmadi, and as discussed in col. 1, lines 43-45, in order to operate, the Ahmadi tool must be co-planar with the Ahmadi “ringprosthesis” device in order to connect to the Ahmadi device ring and in order that the tool may act on the “thrust bearing” that is disposed at a “side opposite the insertion opening” (Col. 1, line 43-45). When in place on tissue, such a tool must lie along a plane of the implant ring. Use of a tool in a co-planar orientation would create, at least, significant difficulties in conducting adjustment of an annular device after attachment to adjacent tissue. For example, the orientation of the Ahmadi device, once attached, would prevent visibility of the tool engagement point required to adjust the device. Furthermore, removal of the adjustment tool from the attached implant would be prevented by the anatomical boundaries of, for example, the arterial wall.

In contrast with Ahmadi, claim 1 of the present application recites, in part, a method that comprises:

adjusting size or shape of said adjustable implant device using an adjustment tool operably engaged with said docking mechanism, wherein said adjustment tool has a proximal portion and a distal portion, and wherein, when operably engaged, at least the distal portion of said adjustment tool is disposed in a non-planar orientation with respect to said plane defined by said implant device.

Because Ahmadi fails to teach or suggest a method that includes use of an engaged tool having a non-planar orientation with respect to an implant device, Applicants submit that Ahmadi does not teach or suggest all the features of claim 1. Thus, Ahmadi fails to anticipate the present invention. Furthermore, Applicants note the difference in orientation of the tool in the claimed method is not insubstantial due to the significant problems caused by the arrangement of Ahmadi, as discussed above.

Claims 2-5 depend directly or indirectly from claim 1 and are, thus, distinguishable over Ahmadi for at least the same reasons as claim 1.

In light of the foregoing, Applicants respectfully request withdrawal of the rejection of claims 1-5 under 35 U.S.C. § 102(b) with respect to Ahmadi.

New claims 23-34 also depend from claim 1 and so include all the elements of claim 1.

Application No.: 10/651,851
Amendment dated January 11, 2007
Reply to Office Action dated July 11, 2006

Thus, Ahmadi also fails to anticipate the subject matter of claims 23-34 for at least the same reasons as provide for claim 1.

New claims 35-39 are also distinguishable from Ahmadi in that the claimed method does not include use of a co-planar adjustment tool. Review on the merits is respectfully requested.

CONCLUSION

In view of the foregoing, Applicants submit that this application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that the prosecution of this case might be advanced by discussing the application with Applicants' representative, in person, or over the telephone, Applicants' representatives would welcome the opportunity to do so.

EXCEPT for fees payable under 37 CFR §1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application, including fees due under 37 CFR §1.16 and 1.17 which may be required, including any required extension of time fees, or credit, any overpayment to deposit account No. 50-1349. This paragraph is intended to be a constructive petition for extension of time in accordance with 37 CFR §1.136(a)(3).

Respectfully submitted,

Dated: January 11, 2007

By: Thomas W. Edman
Celine Jimenez Crowson
Registration No. 40,357

HOGAN & HARTSON LLP
555 13th Street, N.W.
Washington, D.C. 20004
Telephone: (202) 637-5600
Facsimile: (202) 637-5910
Customer No. 24633

Thomas W. Edman
Registration No. 51,643